

## REMARKS

The Examiner rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by the patent to Saha. In response, Applicants have amended claim 1 and respectfully traverse the rejection.

The present invention relates to determining the position of a mobile terminal capable of communicating voice and packet data over a circuit-switched network, and a packet data network, respectively. In one embodiment, the mobile terminal is engaged in an active packet data session and monitors a packet data control channel.

Periodically, the circuit-switched network may request the mobile terminal to provide its location. Because the mobile terminal is camped on the packet data control channel, the circuit-switched network cannot reach the mobile terminal through its own control channel. Therefore, a base station sends a paging request indicating a circuit switched service to the mobile terminal over the packet data control channel. Responsive to the paging request, the mobile terminal switches to the control channel for the circuit-switched network, and sends a paging response. The circuit-switched network can then determine the position of the mobile terminal.

To clarify this aspect of Applicants' invention, claim 1 has been amended to explicitly require "transmitting a paging request to a mobile terminal via a first control channel for packet data services ... switching from the first control channel to a second control channel for circuit-switched services ... [and] receiving a paging response from the mobile terminal via the second control channel." Further, claim 1 now requires that "the paging request [indicate] a circuit switched service."

Saha teaches using Location Mobile Units (LMUs) and a Time of Arrival (TOA) method to determine the position of GPRS mobile terminals within a packet data network. In Saha, a base station sends a paging request to the mobile terminal over a packet control channel. The mobile terminal responds to the request by sending a paging response to the base station. However, in contrast to the requirements of claim 1, the base station does not receive the paging response over a circuit-switched control channel. Rather, the base station receives the paging response over a packet control channel. This is because Saha addresses a fundamentally different problem than that of Applicants' invention. More specifically, not all of the LMUs in the network of Saha are able to understand the entire spectrum of GPRS signaling, and thus, cannot determine the position of GPRS-enabled mobile terminals. Therefore, Saha uses only those LMUs that are able to make TOA measurements for GPRS-enabled mobile terminals. *Saha*, col. 5, ll. 47-55. Thus, the signaling (i.e., the response) in Saha is necessarily sent over a packet data control channel. There is no need in Saha to send or receive a paging response over a circuit-switched channel. Therefore, Saha fails to teach each of the elements of claim 1, and as such, cannot anticipate claim 1 under § 102. Accordingly, Applicant respectfully requests the allowance of claim 1, and its dependent claims 2-6.


The Examiner also rejected claims 7, 12, 16, 22, and 27 under § 102, citing Saha and asserting reasons similar to those stated above with respect to claim 1. However, Applicants have amended each of these claims to include language similar to that of amended claim 1. Thus, for the reasons stated above, Saha also fails to anticipate

claims 7, 12, 16, 22, and 27 under § 102, and Applicants respectfully request the allowance of claims 7-31.

Finally, Applicants have amended various dependent claims to clarify language and correct minor grammatical errors, and added claims 32-41 for consideration by the Examiner. No new matter has been added. The new claims are directed to mobile terminals operating according to the present invention, and contain language similar to that of amended claim 1. For the reasons stated above, Saha fails to anticipate any of the claims 32-41. Accordingly, Applicant respectfully requests the allowance of claims 32-41.

Respectfully submitted,

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